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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/14/2006

Irun R. Cohen

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03/18/2009

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EXAMINER

MARTELLO, EDWARD

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2628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,591	Applicant(s) COHEN ET AL.	
	Examiner Edward Martello	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/06/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1- G06T 17/00 – Three dimensional (3D) modeling, namely claims 1-12, in the reply filed on 10 February 2009 is acknowledged.
2. Claims 13-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 February 2009.
3. Currently, claims 1-12, as modified by the preliminary amendment received 18 July 2005, are pending in the application. The preliminary amendment only removed multiple dependencies from the original claims and the claim text used below shows the resultant state without any markups and is reflective of the how the claims are presented in the U. S. Patent Application Publication of the instant application (US 2006/02210801 A1).

Drawings

4. The drawings are objected to because drawing figures 7b, 9, 10a, 10b, 11 and 13b are too dark and thus are unreadable. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be

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necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

5. The information disclosure statement filed 06 September 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the entries in the "Other Documents" section do not include required information, namely, month and year of publication. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claim 1 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, claim 1 recites a method for producing animation of an object comprising: modeling a behavior of the object as a plurality of events; creating a visual depiction at least of said plurality of events; detecting an event associated with the object; and creating the animation according to said event with said visual depiction which are steps or procedures that do not inherently require any particular machine, article of manufacture or composition of matter and they can be performed manually which is the current practice presented in the background of the invention section of the instant application.

7. Claims 2-8 are rejected under 35 U.S.C. 101 for the same reason as claim 1 since the steps of these claims are not “tied to” another statutory class and are depended from claim 1 which is also non-statutory.

8. Claims 9 and 10 are rejected under 35 U.S.C. 101 for the same reason as claim 1 since the steps of these claims are not “tied to” another statutory class and are depended from claim 1 which is also non-statutory. While these claims provide for receiving an external input and a

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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user interface, these features do not sufficiently tie the methods to a statutory class as there are many types of user interfaces (book, magazine, mail, personal meeting/discussion, physically viewing an event and the like) and receiving an external input can occur with any of these interface instances.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by

Katzenberger et al. (U. S. Patent 5,867,175, hereafter ‘175).

10. Regarding claim 1, Katzenberger teaches a method for producing animation of an object (‘175; graphical object (GOB); Abstract) comprising: modeling a behavior of the object as a plurality of events (‘175; col. 6, ln. 44-66); creating a visual depiction at least of said plurality of events (‘175; col. 6., ln. 60-66; col. 7, ln. 10-18); detecting an event associated with the object (‘175; col. 7, ln. 50-65); and creating the animation according to said event with said visual depiction (‘175; col. 7, ln. 66 through col. 8, ln. 7). {Quoted from ‘175 col. 16, ln. 27-33 is an example of a reactive animation of a cat. (“A representative example of a script for implementing an interactive animation sequence is shown in Table IV. This script supports an animation sequence for presenting an image of a “cat” that chases a cursor as the cursor moves from one position to the next on a [displaced – appears to be a typo] display screen. Thus for

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each frame of the animation sequence, the location of the cat is dependent upon the location of the cursor.”}}.

11. In regard to claim 2, Katzenberger further teaches wherein said plurality of events comprises a plurality of temporal samples or a plurality of scenarios (‘175; col. 16, ln. 27-33; a temporal sequence of a reactive animation of a cat).

12. Regarding claim 3, Katzenberger teaches the method according to claim 1 and further teaches wherein said plurality of events comprises a plurality of states (‘175; fig. 4; col. 9, ln. 52 through col. 10, ln. 13).

13. In regard to claim 4, Katzenberger further teaches the method as further comprising: determining at least one transition between said plurality of states (‘175; fig. 4; col. 9, ln. 52 through col. 10, ln. 13).

14. Regarding claim 5, Katzenberger further teaches wherein said at least one transition is determined according to at least one rule (‘175; col. 10, ln. 7-14; determines whether the specified event serves to invoke a script interpreter).

15. In regard to claim 6, Katzenberger teaches the method of claim 3 and further teaches wherein said creating said visual depiction further comprises creating a visual depiction of said at least one transition (‘175 col. 16, ln. 27-33; a temporal sequence of a reactive animation of a cat).

16. Regarding claim 7, Katzenberger teaches the method of claim 3 and further teaches wherein said state represents an interaction between a plurality of objects (‘175; col. 8, ln. 20-28; a representative example of interaction between GOBs).

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17. In regard to claim 8, Katzenberger teaches the method of claim 3 and further teaches the method as further comprising: interacting between a plurality of objects; and altering a state of at least one object according to said interacting ('175; col. 14, ln. 34-42).

18. Regarding claim 9, Katzenberger teaches the method of claim 3 and further teaches the method as further comprising: receiving an external input; and altering a state of at least one object according to said external input ('175; col. 7, ln. 50-65; col. 16, ln. 27-33; a temporal sequence of a reactive animation of a cat).

19. In regard to claim 10, Katzenberger further teaches wherein said external input is provided through a user interface ('175; col. 7, ln. 50-65).

20. In regard to claim 12, Katzenberger teaches the method of claim 3 and further teaches wherein said detecting said state is performed by a state engine ('175; script interpreter; col. 6, ln. 33-66), and wherein said creating the animation is performed by an animation engine ('175; col. 7, ln. 3-18; rendering engine), the method further comprising: receiving a command from said state engine; parsing said command to determining said state of said object; and translating said command to a format for said animation engine for creating the animation ('175; col. 6, ln. 33 through col. 7, ln. 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katzenberger et al. (U. S. Patent 5,867,175, hereafter '175) as applied to claims 1-10 and 12 above.

22. Regarding claim 11, Katzenberger teaches the method of claim 10 but does not explicitly teach wherein said user interface is for interacting with a computer game. Katzenberger, however, states that computer programs are available to address the animation of an object and "These computer-supported animation techniques are commonly used by artists to create animated sequences for movies, television programs, computer programs, and video games." ('175; col. 1, ln. 18-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to make use of the animation creation methods, state scripting methods and rendering engine teachings of Katzenberger for the benefit of providing a user interface for interacting with a computer game. Additionally, the cite used in claim 1 above, could be viewed as a simple computer game interface. {Quoted from '175 col. 16, ln. 27-33 is an example of a reactive animation of a cat. ("A representative example of a script for implementing an interactive animation sequence is shown in Table IV. This script supports an animation sequence for presenting an image of a "cat" that chases a cursor as the cursor moves from one position to the next on a [displaced – appears to be a typo] display screen. Thus for each frame

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of the animation sequence, the location of the cat is dependent upon the location of the cursor.”}}.

Conclusion

The following prior art, made of record, was not relied upon but is considered pertinent to applicant's disclosure:

US 20030179204 A1	Method and apparatus for computer graphics animation
US 20030052919 A1	Animated state machine
US 6414684 B1	Method for communicating and generating computer graphics animation data, and recording media

In addition, the Examiner believes that the following art, already of record, includes all of the elements of the elected invention.

US 6208357 B1	Method and apparatus for creating and animating characters having associated behavior
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Martello whose telephone number is (571) 270-1883.

The examiner can normally be reached on M-F 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached on (571) 272-7761. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EM/

Examiner, Art Unit 2628

/XIAO M. WU/

Supervisory Patent Examiner, Art Unit 2628